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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,732	03/29/2001	Yousuke Tanaka	0397-0424P	4354

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EXAMINER

CAMPBELL, THOR S

ART UNIT PAPER NUMBER

3742

DATE MAILED: 03/31/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,732

Applicant(s)

TANAKA, YOUSUKE

Examiner

Thor S. Campbell

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2003 and 05 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14, 16 and 23-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 23-38 is/are rejected.
- 7) ☐ Claim(s) 14 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-8, 11, 23-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Klein (US 4399711).

Klein discloses an automated pipette including a metering pump including a cylinder having openings and a cavity, a piston inserted in the cavity, a driving source for moving the piston, and a pipette directly connected to the opening of the cylinder, wherein the pipette is disposable and detachably connected for dispensing a sample of biological fluid to be tested, further wherein the metering pump is driven by a stepper motor to advance a piston in a cylinder. It is noted that the pipette of Klein is disclosed as for use with the automated nephelometer or of US 4298570 (col. 2, lines 52-54) incorporating the teachings of Anderson et al. (US 4157871).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein in view of JP 2-080937A.

Klein discloses the claimed invention except the cleaning fluid channel extending from the outer circumference of the cylinder. Klein discloses that after a sample is processed the pipette is washed (col. 3, line 48). JP 2080937A discloses a pipette-dispensing device having a radially extending passage for flowing cleaning fluid therethrough. It would have been obvious to one of ordinary skill in the art to modify the device of Klein to include a passageway for flowing a cleaning fluid through the dispensing device in order to eliminate contamination from one sample to the next and to further automate the process.

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein in view of JP 09133686A.

Klein discloses the claimed invention except a liquid surface detection circuit that senses the contact with the sample surface by the change in capacity of the circuit. JP 09133686A discloses a pipette-dispensing device having a liquid surface detection circuit that senses the contact with the sample surface by the change in capacity of the circuit. Klein discloses that conductivity probes could be used in place of optical sensors (col. 4, lines 33-35). It would have been obvious to one of ordinary skill in the art to modify the device of Klein to include a liquid surface detection circuit that senses the contact with the sample surface by the change in capacity of the circuit in order to provide an accurate means for sensing sample presence prior to sucking in the sample.

Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Klein in view of Kogo et al (US 4891575).

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Klein discloses the claimed invention except the analyzing section that counts the pulses due to a change in electrical impedance. Kogo discloses a particle detection system using an aperture and a current to count the pulses of impedance due to a presence or absence of cells in the circuit. It would have been obvious to one of ordinary skill in the art to modify the device of Klein to include an analyzing section as described by Kogo in order to provide an accurate count of the red or white blood cells in a sample.

Allowable Subject Matter

Claims 14, 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thor S. Campbell whose telephone number is 703-306-9042. The examiner can normally be reached on Tue-Fri 5:30AM-4:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Denise Pothier can be reached on 703-308-0265. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

**THOR CAMPBELL
PATENT EXAMINER**

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TSC


THOR CAMPBELL
PATENT EXAMINER